

REMARKS

Claims 169-187 and 189-200 are pending in the application. The Applicants respectfully request that the application be reviewed in view of the following comments.

Provisional Obviousness-Type Double Patenting Rejection

Claims 169-187 and 189-200 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 164-327 of both copending Application Nos. 09/541,170 and 09/542,487. The Applicants have previously filed a terminal disclaimer (July 29, 2002) that included these applications. Thus, the provisional obviousness-type double patenting rejection has already been overcome and should be withdrawn.

Information Disclosure Statement ("IDS")

The Applicants would like to note that they have not apparently received an initialed copy of the Sixth IDS filed on January 28, 2003. A copy of that IDS is enclosed and the postcard indicating receipt from the PTO on February 3, 2003 is also enclosed. The Applicants respectfully request that the Examiner review these references and make them of record.

35 U.S.C. § 103(a) Rejection

All of the independent claims (claims 169, 178-180, and 189-191) recite, *inter alia*, "the processor being adapted to cause the transport mechanism to halt with a flagged bill being positioned as the last bill in one of the output receptacles." Japanese Patent Publication 61-14557 to Hatanaka et al. ("JP 14557") does not teach or suggest a processor that is adapted to cause the transport mechanism to halt with a flagged bill being positioned as the last bill in one of the output receptacles."

Rather, Applicants believe that JP 14557 discloses a currency discriminator having two destinations for document processing. For example, JP 14557 discloses the following:

The control circuit also has a wrong denomination paper currency discharge unit 123. If a mismatch is indicated by the collation signals RF from the denomination collation unit 114, the detected note of paper currency is not conveyed to the paper currency collection unit 23 but may be discharged from a discharge slot.

Page 7, lines 23-26. Accordingly, the wrong denomination paper currency discharge unit 123 is capable of routing bills to a discharge slot instead of the paper currency collection unit 23.

JP 14557, however, is silent on any further details regarding the bills being routed to the discharge slot. JP 14557 certainly does not teach or suggest that “[t]he erroneous bill is discharged as the last bill transported before the device is shut down” as stated in the Office Action at page 4.

The statement in the Office Action at page 4: “[n]ote also that it would have been obvious for one ordinarily skilled in the art to direct such a bill to any discharge, for example, the discharge where counted bills had been collected, thus making the erroneous bill the last bill on the pile of bills, the counted bills being below the erroneous statement” is conclusory and clearly made with impermissible hindsight. The Applicants respectfully disagree with this assertion and request that the Examiner cite to a prior art reference that allegedly supports such a statement so that the Applicants can evaluate the same and respond accordingly. *See* MPEP 2144.03.

Therefore, independent claims 169, 178-180, and 189-191 are not obvious over JP 14557 and should be in a condition for allowance. Claims 170-177, 181-187 and 192-200, which depend on either 169, 180 or 191 are not obvious over JP 14557 for at least the same reasons and should be allowable.

Comments on Selected Issues in the Office Action

At page 5, section (i) of the Office Action, the term “suspect bill” is recited and Applicants’ definition of a suspect bill is said to be located at page 30, lines 18-24 of the present application. This is incorrect, the Applicants define the term “suspect bill” at page 30, lines 6-7 as “a note that fails one or more authentication tests based on a variety of monitored parameters.” The definition at page 30, lines 18-24 of the present application is for a “stranger” bill and, thus, a “wrong denomination” is not a “suspect bill”.

Additionally, it is noted that JP 14557 does not appear to disclose a no call output receptacle and the details set forth at paragraphs p-x at pages 7-9 of the Office Action. Specifically, JP 14557 does not appear to disclose the following: (a) “the second set of output receptacles includes a receptacle designated as a no call output receptacle”; (b) “halting occurs after a no call bill has been delivered to the no call output receptacle”; (c) “halting occurs with

the no call bill being positioned at an identifiable location in the no call receptacle”; (d) “the halting occurs with the no call bill being the last bill transported to the no call output receptacle”; (e) “halting occurs before a no call bill has been delivered to the no call output receptacle”; (f) “halting occurs with the no call bill being located at an identifiable location within the transport path”; (g) “the halting occurs after the no call bill has been delivered to an output receptacle of the second set”; (h) “the halting occurs with the no call bill being positioned at an identifiable location in an output receptacle of the second set”; and (i) “halting does not occur after a no call bill or a stranger bill has been delivered to an output receptacle of the second set.”

At pages 5-7 and 9 of the Office Action, sections “k”, “l”, “m”, “n”, “o”, and “y” of the Office Action, there is discussion on the following: a transportation rate of 800 bills/min, a third output receptacle, “generating a characteristic information output signal in response to detected characteristic information via the detector”, “producing tracking signals in response to the physical movement of bills”, “determining the face orientation of the bills” and “the counting and determining of the currency bills is performed independent of the size of the bills”. Since these claim limitations are not present in any of the pending claims, the Applicants will not address these issues herein. The fact that we will not be addressing these moot claim limitations does not in any manner mean that the Applicants agree with any of the assertions presented in the Office Action.

The Applicants also will not be addressing the other references mentioned at pages 10-11 since these references have not been applied in the Office Action. The Applicants, however, note that none of these references anticipates or renders obvious the pending claims.

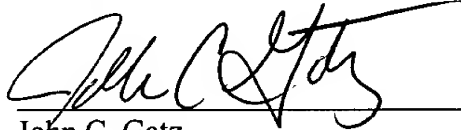
Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. It is believed that no fee is presently due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00268.

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Respectfully submitted,

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